

REMARKS

Claims 38-39, 44, 46, 50-51, 56, 58, 62-63, 68, and 70 are rejected, under 35 U.S.C. §102(e). However, the rationale for rejecting Claims 38-39, 44, 46, 50-51, 56, 58, 62-63, 68, and 70 is provided, under 35 U.S.C. §103(a). Appropriate correction is requested.

Claim Rejections - 35 U.S.C. §102

Claims 38-44, 46-48, 50-60 and 62-75 are rejected, under 35 U.S.C. §102(e), as being allegedly anticipated by Blume (U.S. 6,915,103) (hereinafter Blume). Applicants respectfully traverse in view of the following.

Independent Claim 73 recites that in response to determining the first position, mapping the first position to a location in memory that a first instructional response associated with the first location is stored, wherein the first instructional response is an instruction from the computing device for use by a user of the computing device, as claimed. Accordingly, the first instructional response is done in response to determining the first position resulting from a user selection of a first print element.

In contrast, Blume discloses that a synchronized audio book allows a reader to follow along in the book (see Blume, col. 1, lines 29-31). A synchronized audio book may output a message “turn the page when you hear the BEEP” (see Blume, col. 1, lines 31-32). Blume discloses that the

synchronized audio book requires the reader to progress at the pace of the recording (see Blume, col. 1, lines 33-35).

Accordingly, the page turn message is done in response to the audio book reaching the end of the page independent of any action by the user, as disclosed by Blume. As such, Blume fails to teach or suggest the first instructional response in the claimed fashion because the page turn message, as disclosed by Blume, is done independent of any action by the user and is not in response to determining the first position resulting from a user selection of a print element, as claimed.

Applicants respectfully wish to remind the Examiner that anticipation requires the disclosure in a single prior art reference of each claim under consideration (see *W.L. Gore & Assocs. v. Garlock Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)). However, it is not sufficient that the reference recite all the claimed elements. As stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention “arranged as in the claims” (see *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)).

Accordingly, merely choosing various elements from different embodiments (e.g., Background and detailed description) fails to teach or suggest the recited claim because the cited passages are not arranged in the claimed fashion. For example, Blume discloses that a synchronized audio system

requires the reader to progress at the pace of the recording (see Blume, col. 1, lines 33-35). Thus, one is dissuaded from using the synchronized audio system because the user is forced to progress at the pace of the recording, as disclosed by Blume whereas the first instructional response, as claimed is done in response to determining the first position resulting from a user selection of a first print element. Accordingly, the teachings of Blume are not arranged in the claimed fashion, as required.

Accordingly, Blume fails to anticipate independent Claim 73, under 35 U.S.C. §102(b). Independent Claims 74 and 75 recite limitations similar to that of independent Claim 73 and are patentable for similar reasons. Claims 57 and 69 are patentable for similar reasons that independent Claim 73 is patentable. Dependent claims are patentable by virtue of their dependency.

As per Claims 42, 54 and 66, Blume discloses providing an audio feedback, e.g., a definition of a word, or confirming an answer, etc. (see Blume, col. 7, lines 50-54). An audio feedback, as disclosed by Blume, differs from a task being audibly presented to the user, as claimed.

As per Claims 48, 60 and 72, Blume discloses a system that includes a stylus and an output device (see Blume, col. 3, lines 10-11 and Figure 1, elements 14 and 16). Blume discloses that the output device may be contained in a housing that includes a microprocessor and an audio speaker (see Blume, col. 4, lines 46-49 and Figures 1 and 2, elements 14, 16, 40 and 42). The output

device, as disclosed by Blume, is box shaped (see Blume, Figures 1 and 2, element 16). Thus, Blume fails to teach or suggest that the processor, the input device, the output device and the writing device form a housing having a pen-like appearance, as claimed.

As such, allowance of Claims 38-44, 46-48, 50-60 and 62-75 is earnestly solicited.

Claim Rejections - 35 U.S.C. §103

Claims 38, 39, 46, 50-51, 56, 58, 62, 68 and 70 are rejected, under 35 U.S.C. §103(a), as being allegedly unpatentable over Blume in view of Kardach (U.S. 2003/0001020) (hereinafter Kardach). Claims 38, 39, 46, 50-51, 56, 58, 62, 68 and 70 depend from independent Claims 73, 74 and 75 and are patentable over the cited references by virtue of their dependency.

For the above reasons, the Applicants request reconsideration and withdrawal of the rejections under 35 U.S.C. §102 and 35 U.S.C. §103.

CONCLUSION

In light of the above listed remarks, reconsideration of the rejected Claims is requested. Based on the arguments presented above, it is respectfully submitted that Claims 38-44, 46-48, 50-60, and 62-75 overcome the rejections of record and, therefore, allowance of Claims 38-44, 46-48, 50-60, and 62-75 is earnestly solicited.

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Respectfully submitted,
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